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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Reza Green, Esq.
Novo Nordisk of North America, Inc.
100 COLLEGE RD. W.
PRINCETON, NJ 08540-6604

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,574

Applicant(s)

JEPPESEN ET AL.

Examiner

Brenda Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7,17,45-47,54 and 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,17,45-47,54 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/419,761.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Claims 1, 2, 7, 17, 45-47, 54 and 55 are pending in the application.

This action is in response to applicants' amendment filed August 5, 2004.

Claim 54 has been amended.

Change of Examiner

Note the change of Examiner in the present application. The Art Unit number (1624) remains the same.

Response to Amendment

In view of the amendments and arguments in the response of August 5, 2004, all the rejections of record have been overcome. However, upon further search and review, the **finality of the previous office action is withdrawn** and the new grounds of rejection below are seen necessary.

Note: The applicants' are reminded of the manner of making amendments.

37 CFR § 1.121 Manner of making amendments in application.

(c) Claims. Amendment to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims in the amendment document will serve to replace all prior versions of the claims in the application. In the claim listing, **the status of every claim must be indicated** after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

Claim 50 is not present and claim 52 appears twice.

Priority

1. The applicants have indicated in the first line of the specification that this application is as follows:

This application is a divisional application of application serial no. 09/419,761 tiled October 19, 1999, **now allowed**, which claims priority under **35 U.S.C. 119 of Danish application PA 1998 01352 tiled October 21, 1998**, and of U.S. Provisional application 60/105,912 tiled October 28, 1998, the contents of which are fully incorporated herein by reference.

The first line of the specification must indicate any applications which where filed under 35 U.S.C. §§ 119(e) or 120. However, any foreign priority document, i.e. PA 1998 01352 should not be cited in this paragraph.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 45 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The first three species on page 7 of the amendment are not described in the specification

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where (10,11-Dihydro-dibenzo[*b,f*]azepin-5-yl) is substituted on the propoxy at the three position.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1, 2, 7, 17, 45-47, 54 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 1, 2 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R^1 , R^2 , R^3 , and R^4 where "optionally substituted with one or more halogen, perhalomethyl, hydroxyl, nitro or cyano" appears after the semicolon following the definition of the substituents on the amino within the definition of R^{11} and R^{12} . Clarification is required as to which moiety is substituted.
- b) Claims 1, 7 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of ring A which is optionally substituted with hydrogen.
- c) Claim 1 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R^5 and R^6 where "optionally substituted with one or more halogen, perhalomethyl, hydroxyl,

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nitro or cyano" appears after the semicolon following aralkyl. Clarification is required as to which moiety is substituted.

d) Claim 1 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R^7 and R^8 where "optionally substituted with one or more halogen, perhalomethyl, hydroxyl, nitro or cyano" appears after the semicolon following heteroaralkyl group. Clarification is required as to which moiety is substituted.

e) Claim 7 recites the limitation "cyano, C_{4-7} -alkenynyl, aryloxy, aralkyl, aralkoxy, heterocyclyl, heteroaryl, heteroaralkyl, heteroaryloxy, heteroaralkoxy, acyl, acyloxy, hydroxy C_{1-7} -alkyl, amino, acylamino, C_{1-7} -alkylamino, arylamino, aralkylamino, amino C_{1-7} -alkyl, C_{1-7} -alkoxy C_{1-7} -alkyl, aryloxy C_{1-7} -alkyl, aralkoxy C_{1-7} -alkyl, C_{1-7} -alkylthio, thio C_{1-7} -alkyl, C_{1-7} -alkoxycarbonylamino, aryloxycarbonylamino, aralkoxycarbonylamino, -COR¹¹, or -SO₂R¹², wherein R¹¹ and R¹² independently of each other are selected from hydroxy, perhalomethyl or amino optionally substituted with one or more C_{1-6} -alkyl, perhalomethyl or aryl; optionally substituted with one or more halogen, perhalomethyl, hydroxy or cyano" in the definition of the substituents on ring A. There is insufficient antecedent basis for this limitation in the claim.

f) Claim 45 is vague and indefinite in that it is not known what is meant by propionionate in the 2nd species.

g) Claim 46 is vague and indefinite in that it is not known what is meant by propionionate in the 2nd species.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman
Primary Examiner Art Unit 1624
August 25, 2004